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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,805	01/22/2004	Kiyokazu Ohtaki	27,540 USA	5392

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SYNNESTVEDT & LECHNER, LLP
1101 MARKET STREET
26TH FLOOR
PHILADELPHIA, PA 19107-2950

EXAMINER

EDWARDS, ANTHONY Q

ART UNIT	PAPER NUMBER
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2835

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/762,805	Applicant(s) OHTAKI ET AL.	
	Examiner Anthony Q. Edwards	Art Unit 2835	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 8, 2007 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,275,810 to Waldmeier in view of U.S. Patent Application Publication No. US2002/0164993 to Elliot. Referring to claim 1, Waldmeier discloses a portable device (Figs. 1 and 2) comprising an electronic component (see col. 3, lines 50-53), a portable device body (1) for accommodating and enclosing the electronic component (i.e., within space 8) therein, the portable device body including an upper case (2) and a lower case (3), each having a cavity (not numbered) and being made of a non-metal material (see col. 3, lines 22-25) which inherently permits receipt and transmission of wireless signals therethrough for communication with the electronic component enclosed in the portable device body without significantly reducing the receiving and transmission capability of the electronic component, and a holding member (10)

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for holding peripheral portions of the upper case and the lower case so that the upper case and the lower case are connected to each other with the cavities opposed to each other, wherein the holding member is detachably attached to the portable device body. The purpose of the carrier or portable device of Waldmeier is to safely transport the contents of the carrier, so that an end user of the same may open the carrier and remove those contents. As such, Waldmeier teaches the holding member (10) detachably attached to the portable device body, even though removing the holding member may destroy the carrier casing or body. See col. 2, lines 14-18.

Waldmeier does not specifically disclose the electronic component receiving and transmitting wireless signals. Elliot discloses a method and system for locating and tracking a mobile device, via a mobile transmitter (see paragraph 0026), to ensure that the path of a user intended to be followed is actually followed. See paragraphs 0015-0016. It would have been obvious to one having ordinary skill in the art at the time of the invention to provide the portable device of Waldmeier with an electronic component having wireless locating and tracking means, as taught by Elliot, since the device of Elliot would allow for remotely locating the portable device of Waldmeier for the purpose of tracking the whereabouts of the expensive/precious stones contained therein.

Referring to claim 2, Waldmeier in view of Elliot disclose a portable device as claimed, wherein the holding member (10) holds the upper case (2) and the lower case (3) so as to surround the portable device body. See Fig. 2 of Waldmeier.

Referring to claim 3, Waldmeier in view of Elliot disclose a portable device as claimed, wherein the upper case (2) includes a first flange (4) extending along the peripheral portion of the thereof, the lower case (3) includes a second flange (4) extending along the peripheral portion

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of the lower case (see Fig. 3 of Waldmeier), and the holding member (10) has an inner surface (not numbered) including an engaging groove engaged with the first and second flanges when the upper case and the lower case are connected to each other.

Referring to claim 4, Waldmeier in view of Elliot disclose a portable device as claimed, further comprising a seal (6) arranged between the upper and lower case. See Fig. 3 and col. 3, lines 22-25 of Waldmeier.

Referring to claim 6, Waldmeier in view of Elliot disclose a portable device as claimed, wherein the holding member (10) is made of metal and covers only the peripheral portions of the upper case and the lower case when the upper case and lower case are connected to each other. See Fig. 2 and col. 3, lines 53-55 of Waldmeier.

Referring to claim 7, Waldmeier in view of Elliot disclose a portable device as claimed, wherein the holding member (10) includes a plurality of holding member pieces (11/12), wherein adjacent ones of the holding member pieces are in contact with each other at a location separated from the center of a side of the portable device. See Fig. 2 of Waldmeier, which shows the upper and lower pieces of the holding member contacting each other at the periphery of the device body (1).

Referring to claim 8, Waldmeier in view of Elliot disclose a portable device as claimed, wherein the holding member (10) includes two holding member pieces (11/12) that are made of the same material and have the same shape, with the two holding member pieces holding the peripheral portions of the upper case and the lower case. See Fig. 2 and col. 3, lines 52-57 of Waldmeier.

Referring to claim 11, Waldmeier in view of Elliot disclose a portable device as claimed (see the rejections to claims 1 and 7 above).

Referring to claim 5, Waldmeier in view of Elliot disclose the device as substantially claimed, including the holding member (10) made of metal that is more rigid than the portable device body (1). See col. 3, lines 53-55. Although Waldmeier, as modified, teaches a device body made of glass (col. 3, lines 22-23), as opposed to synthetic resin, the "Background of the Invention" teaches the use plastics in the packing materials in the art. It would have been obvious to a person having ordinary skill in the art at the time of the invention to further modify the device of Waldmeier to include a portable device body made of synthetic resin or plastic to reduce the costs of the device for mass production purposes.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waldmeier in view of Elliot as applied to claim 8 above, and further in view of U.S. Patent No. 5,133,451 to Boyd et al. Referring to claim 9, Waldmeier, as modified, lacks the two holding members (11/12) attached to the portable device in directions intersecting a line perpendicular to the plane of the portable device. Boyd et al. teach a protective holder for a coin, wherein the holder includes two holding pieces (32/34) that attach to a portable device (14a) in directions intersecting a line perpendicular to the plane of the portable device (see Fig. 11). It would have been obvious to one having ordinary skill in the art at the time of the invention to further modify the holding member pieces of Waldmeier, which are attached along the upper and lower plane, respectively, of the portable device body, to attach the same along the side surfaces of the device body, as taught by Boyd et al., since the device of Boyd et al., would reduce the amount of stress

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applied to the top and bottom of the device body, thereby reducing the likelihood of damaging the electronic component of Waldmeier in view of Elliot.

Referring to claim 10, Waldmeier in view of Elliot lacks the two holding members (11/12) in the shape of rectangular pieces. It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the holding member pieces of Waldmeier in view of Elliot to provide rectangular frame-like pieces, since it has been held that mere changes in shape, absent persuasive evidence that the particular configuration of the claimed invention is significant, involves only routine skill in the art. *In re Daily*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Response to Arguments

Applicant's arguments filed March 8, 2007 have been fully considered but they are not persuasive. As indicated in the above rejection to claim 1 (and even as applicant has noted in page 6 of the Remarks), Waldmeier does disclose the holding member (10) being removable or separated from the device body, i.e., "detachably" attached to the portable device body. It just so happens that detachably removing the holding member of Waldmeier from the device body (1) may also destroys the device body, so that tampering of the body may be readily identified.

Applicant also argues in page 7 of the Remarks that "*One having ordinary skill in the art does not intend to encase an electronic component in the disks 2 and 3 of Waldmeier. The reason follows: An electronic component that transmits and receives wireless signals requires routine maintenance, such as replacement of the battery, that requires one to open the portable device body.*" The Examiner disagrees with this argument, since (a) Waldmeier clearly teaches that an electronic component is encased between disks 2 and 3 (see col. 3, lines 50-3), and (b) it does not

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matter whether or not the electronic component needs routine maintenance, because those features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

This is a request for continued examination under 37 CFR 1.114. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Q. Edwards whose telephone number is 571-272-2042. The examiner can normally be reached on M-F (7:30-600) First Friday Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jayprakash N. Gandhi can be reached on 571-272-3740. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

March 15, 2007

aqe

 **ANATOLY VORTMAN
PRIMARY EXAMINER**